

REMARKS

Claims 1-21 are currently pending in the application. All claims stand rejected under 35 U.S.C. §103 as obvious over U.S. Patent No. 6,370,696 (Kronenberger).

Reconsideration of the rejection of claims 1-21 is requested.

In rejecting the claims, the Examiner relies upon the case In re Seid, 161 F.2d229.73 USPQ 431 (CCPA 1947). The Examiner cites this case for the proposition that "matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art" (Examiner's Action, page 3, lines 2-4).

While the Applicant recognizes the law to be consistent with the Examiner's statement thereof, it is respectfully submitted that the facts and issues in In re Seid do not correspond to those at hand. In re Seid dealt with the issue of distinguishing the "particular shape and arrangement of the upper part of the body in the Appellant's figure" from the prior art (at page 433).

Whereas In re Seid dealt with Appellant's argument that there was patentable significance in terms of the shape and arrangement of a simulation of a human figure, compared to the prior art, the subject matter at hand is significantly different, as are the associated issues related to patentability. Applicant's claim 1, for example, is not directed to any specifics of a shape, such as in In re Seid. Applicant does not propose that the claimed subject matter is distinguishable from the prior art by reason of any specific design shape, but rather on the basis of the nature of the different types of information and the strategic location thereof on a headwear piece.

As set forth in Applicant's claim 1, the invention is directed to a headwear piece with

a crown that can, for purposes of identifying location, be viewed as made up of "octants", specifically identified with front, rear, and side designations. The claim is further directed to the application of first and second specific information, with the first information characterized as identifying an event, and the second information as identifying a plurality of participants in the event. Aside from the specific description of the information, the information is claimed to be strategically located on the cap, which has significance in terms of what information is seen from different vantage points by a user. As explained further below, the headwear piece might be worn by participants in a baseball game, with the exact same headwear piece doubling as a valuable souvenir, enhanced by reason of the second information.

On page 11, beginning at line 8, through page 12, line 5 of Applicant's written description, the functional advantages of the structure as in claim 1 are set forth, based upon a specific example. For example, first information that is on at least one of the front/left side and front/right side octants relates to an event, such as a particular competitive event or series involving two or more teams, such as a playoff game or an all star game. The second information relates to participants in the event, be it two of the participants going head-to-head in the competition or individuals/teams that are in a league, a conference, etc., that do or could participate in the event.

By reason of its location, the first information pertaining to the event can be seen from the front of the headwear piece, whereas the second information may not be clearly viewable, unidentifiable, or potentially not seen at all from the same perspective.

As noted, for example, in Applicant's specification, on pages 11 and 12, those viewing the headwear piece from the front thereof will be apprised of the identification of

the event, without dominance of the information relating to the participants. As the viewer's perspective changes, the information relating to the participants can be focused upon. Thus, the headwear piece affords a unique function by highlighting the information relating to the event, while bearing the additional information that makes the headwear piece valuable, as for a souvenir hunter. Thus, the headwear piece, in one form, can be used by participants in the event, and will provide a valuable souvenir for the public by reason of the second information being present.

Based upon In re Seid, the Examiner has essentially eliminated the claimed information in the consideration of patentability, concluding that "it would have been obvious to place logos/information on the cap as it provides no structural limitations to the cap" (Examiner's Action page 2, lines 20, 21).

However, it is respectfully submitted that it is inappropriate to ignore printed information, and its content, in determining whether an invention is patentable. In In re Gulack 217 USPQ 401 (Fed. Cir. 1983), the Court dealt with the issue of printed matter on a band and stated "[d]ifferences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter" (at page 403).

The court stated further "[u]nder section 103, the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole" (at page 403).

It is respectfully submitted that the Examiner has done that which the Federal Circuit has expressly prohibited in In re Gulack 217 USPQ 401 (Fed. Cir. 1983); that being to ignore the content of the printed subject matter.

Additionally, the Court in In re Gulack 217 USPQ 401 (Fed. Cir. 1983) concluded that for the claimed printed matter to distinguish over the prior art, the printed matter must be “functionally related to the substrate” (at page 404).

In the present case, as noted above, the arrangement of the first and second information is functionally related to the substrate/cap. A viewer sees different information, depending upon the viewer’s perspective, which is tied into the function of the headwear piece. The front view of the headwear piece has the first information relating to the event. The front view is the prominent view at which conventionally critical, and potentially all, information, such as a team logo, identity, etc. is placed. From this perspective the event can be readily identified by an observer by viewing the first information. Thus, the headwear piece can be worn by participants during the event, with the event prominently identified through the first information, as claimed, as would be desired by the event promoter, without having the same obscured by the secondary “second information”, that is aimed more at souvenir hunters. This secondary information can be discerned from different perspectives, without detracting from the prominence of the first information.

In short, it is respectfully submitted that as mandated in In re Gulack 217 USPQ 401 (Fed. Cir. 1983), each claim must be read as a whole without disregarding, in this case, the nature or arrangement of the information. While Kronenberger discloses a headwear piece with information thereon, the information is not the same as that set forth in the Applicant’s claims, nor is it functionally related to the headwear piece to provide front-viewable first information that is not detracted from by potentially secondary information that may be provided primarily for souvenir hunters. Further, to arrive at the claimed arrangement, one

would have to modify Kronenberger with Applicant's current invention in hand as a template. Kronenberger, on its own, does not have any teaching or suggestion of any modification in line with the structure recited in Applicant's claim 1. More specifically, as seen in the figures of Kronenberger, the information on the crown is consistently at the front/left side and front/right side octants with no related information on the other octants.

Claims 2-21 depend cognately from claim 1 and recite further significant structural detail to further distinguish over the Kronenberger reference. Numerous dependent claims relate to more specific unique arrangements of the second information.

Reconsideration of the rejection of claims 1-21 and allowance of the case are requested.

Respectfully submitted,

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